

Express Mail No. EL 998649021 US

**REMARKS**

Upon entry of this Amendment A, claims 1-36, 38, and 64-98 are currently pending and under consideration. Claims 37 and 39-63 are cancelled by this amendment; in cancelling this subject matter from this application, applicants expressly reserve the right to pursue the remaining subject matter through one or more continuation applications. According to the Office action mailed December 30, 2003, claims 1-32, 64-72, 75-79, 82-86, and 89-90 are allowable.

New claims 91-98 are supported in the specification. In particular, support for claim 91 can be found, for example, in the claims as originally presented and at page 4, lines 19-28. Support for claim 92 can be found, for example, in the claims as originally presented and at page 4, lines 19-25 and 28-31. Support for claim 93 can be found, for example, in the claims as originally presented and at page 4, lines 19-25 and line 34. Support for claim 94 can be found, for example, at page 4, lines 13-15. Support for claim 95 can be found, for example, at page 4, lines 10-15. Support for claim 96 can be found, for example, in the various series of compounds disclosed in Example 4. Specifically, support can be found in series A1, B1, C1, D1, E1, F1, G1, H1, I1, J1, and K1 wherein  $X_3$  is heterocyclo and  $X_5$  is -COOX<sub>10</sub>. Claim 96 is further supported by Compound 6577 wherein  $X_3$  is 2-furyl,  $X_5$  is -COOX<sub>10</sub> and R<sub>10a</sub> is acetyloxyacetyloxy. Support for claim 97 can be found, for example, in the claims as originally filed and in the exemplary preferred substituents at page 4, lines 19-21. Support for claim 98 can be found, for example, in the exemplary preferred substituents at page 4, lines 25-28.

I. Rejection Based 35 U.S.C. §102

Reconsideration is requested of the rejection of claims 33-40, 47-50, 54-59, 62, 73, 74, 80, 81, 87, and 88 under 35 U.S.C. §102(b) as being anticipated by compounds of the formula (I) of Bouchard et al. (US 5,556,877). Claims 39, 40, 47-50, 54-59, and 62 have been cancelled thus rendering moot this rejection as applied to these claims.

Express Mail No. EL 998649021 US

The standard for determining a rejection based on anticipation is that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.<sup>1</sup> This standard is not met for any of claims 33-40, 47-50, 54-59, 62, 73, 74, 80, 81, 87, and 88. Bouchard et al. describe taxane derivatives possessing other than an unsubstituted benzyloxy moiety at C2, stating at col. 2, lines 7-8 "...it being understood that R<sub>3</sub> cannot represent an unsubstituted phenyl radical."<sup>2</sup> Further, in compliance with this requirement, all of the exemplified taxanes disclosed by Bouchard et al. possess a substituted benzyloxy moiety at C2. In contrast, the taxanes defined by claim 33 require an unsubstituted benzyloxy moiety at C2 (see formula in claim 33 wherein the C2 substituent is BzO). All of the remaining claims at issue ultimately depend from independent claim 33 and thus incorporate all of the limitations thereof. Consequently, none of the claims cited by the Office are anticipated by the taxanes described by Bouchard et al.

II. Nonstatutory Double Patenting Rejection

The Office has rejected claims 33-63, 73, 74, 80, 81, 87, and 88 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 42-74, 84-92, 98, and 99 of US 6,664,275 (Holton). If deemed appropriate, applicants will file a terminal disclaimer once all other rejections have been removed.

---

<sup>1</sup>Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987).

<sup>2</sup>The C2 substituent is defined in formula (I) by Bouchard et al. as "-OCOR<sub>3</sub>".

FSUM 10463.21  
PATENT

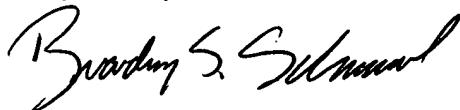
Express Mail No. EL 998649021 US

**CONCLUSION**

In light of the foregoing, applicants request entry of the claim amendments and withdrawal of all claim rejections, and solicit an allowance of the claims. The Examiner is invited to contact the undersigned attorney should any issue remain unresolved.

The Commissioner is hereby authorized to charge any under payment or credit any over payment to Deposit Account No. 19-1345.

Respectfully submitted,



Bradley S. Schammel, Reg. No. 54,667  
SENNIGER, POWERS, LEAVITT & ROEDEL  
One Metropolitan Square, 16th Floor  
St. Louis, Missouri 63102  
(314) 231-5400

BSS/vlm